

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

REMARKS

Reconsideration and allowance are requested. No claims are amended.

Rejection of Claims 1 - 20 Under Section 103

The Examiner rejects claims 1 - 20 under Section 103 in view of U.S. Pat. No. 6,076,109 to Kikinis ("Kikinis") in view of U.S. Pat. No. 6,611,812 to Hurtado ("Hurtado"). Applicants traverse this rejection and submit that there is no motivation to combine these references. In the previous office action and response, the issue of whether any motivation existed to combine these references was not addressed. Therefore, Applicants respectfully submit that in view of the discussion below regarding the lack motivation to combine these references, claims 1 - 20 are patentable and in condition for allowance.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification of the prior art would change the principle operation of

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principles outlined in both these cases are applicable to the present case.

Applicants also note with reference to the discussion below, that the MPEP requires that each prior art reference must be considered in its entirety, as a whole, including portions that would lead away from the claimed invention. MPEP 2141.02. Further, the Examiner must consider the entire teachings of each reference when weighing the power of each reference to suggest solutions to one of skill in the art and whether one of skill would combine the teachings of two or more references. MPEP 2143.01.

Regarding claim 1, Applicants respectfully submit that there is no reason to combine the references to reject this claim. Kikinis teaches a system geared towards low-end computers such as portable, battery powered computers incapable of sophisticated Internet browsing functions. Kikinis describes in the Background of the Invention section how what is needed in the art is an apparatus and method where web browsing may be accomplished with small, battery-powered portable computers while accomplishing a life-between-charge of a week or more without requiring especially heavy batteries. It is clear from the Abstract, Background of the Invention, and throughout Kikinis that his focus is on the battery life of a handheld device.

To provide the solution to the battery-life problem, Kikinis introduces the proxy-server connected to the handheld device. The proxy server accesses Internet servers and reduces the information density so that the handheld device uses less battery power. Col. 2, lines 32 - 53. As mentioned by the Examiner, Kikinis does disclose an ID associated with a user account to the proxy server. Col. 9, lines 55 - 65. In this regard, the user must log into the proxy server by entering a valid ID at which point the user can obtain the services of the proxy server regarding information reduction appropriate to the handheld device.

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

The Examiner concedes on page 4 of the Office Action that Kikinis fails to disclose preventing a user from accessing web clipping applications that are installed on the electronic device and located within the installed software. The Examiner then asserts that Hurtado discloses this feature by equating this step in claim 1 to Hurtado's disclosure about preventing access to the end user of an encryption key on the user device to prevent piracy of sharing of content with other computers referencing column 87, lines 10 - 67 and column 88. The Examiner further concludes that it would be obvious for one of skill in the art to modify Kikinis with the teachings of Hurtado "because it would allow to include [sic] preventing a user from accessing web clipping applications that are installed on said electronic device and located within said installed software with the motivation to establish a secure, global distribution system for digital content that protects the rights of content owners."

We note the teachings as a whole of Hurtado. This is a reference that entirely focuses on delivering encrypted digital content to an end user for playing the content. Hurtado introduces a scheme to protect digital content (movies, audio, multi-media, etc.) by creating a secure container containing a decrypting key for at least partially decrypting encrypted content. On the end user machine is an encryption key of the end user which is used to access the decrypting key for decrypting at least part of the encrypted content. See Abstract.

The portion of Hurtado referenced by the Examiner discusses the component of the public/provide key 661 pair that is created for the end user device. The component is a random symmetric key (Secret User Key) that is generated for protecting song encryption keys in a licensed database. The Secret User Key is protected by breaking the key into multiple parts and storing pieces of the key in multiple locations on the end user device. Therefore, the key stored on the end user device disclosed by Hurtado has a purpose of preventing piracy of sharing of content on that end user device with other computers. Applicants note that the NapsterTM peer-to-peer copyright issues known by one of skill in the

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

art appears to be addressed by this solution. For example, col. 5, lines 11 - 15 in Hurtado states that there is a need in the art for a set of tools to enable an end user to manage a local library of digital content without allowing that end user to have access to the content for uses other than what was purchased.

It is clear that Hurtado has a certain focus that relates to protecting content from piracy. The end of most paragraphs in the "Description of the Related Art" section of Hurtado identify the needs in the art. These needs relate to such things as making content available while protecting digital assets (col. 2, lines 14 - 17), secure digital content distribution (col. 2, lines 31 - 35), rights management for the protection of ownership rights of the content proprietor (col. 5, lines 35 - 42) and so forth. There is no hint in Hurtado of any desire or focus on improving the battery power of handheld devices. Further, there is no hint or suggestion regarding any kind of webclipping application or use. The focus of Hurtado is on the protection of proprietary content from piracy. Applicants urge that the teachings of Hurtado in their entirety and as a whole must be considered for their suggestive power relative to being combined with a battery-powered, hand-held device which is the focus of Kikinis.

There are in fact several factors that urge away from combining Hurtado with Kikinis. For example, Kikinis notes that web browsing requires complex end-use computers that provide a barrier to receiving increased information for many users. Col. 2, lines 16 - 23. The devices contemplated by Kikinis are low-end, low-power devices with reduced capabilities for viewing content. (Col. 5, lines 1 - 7). The simple fact that Kikinis focuses on a handheld, battery-powered, reduced capability device urges against combining its features with the Hurtado invention which primarily focuses on multimedia and video content delivery - which may not even be possible or desirable on a hand-held, battery powered device. For example, Applicants submit that a handheld device would not be desirable for

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

watching content such as a movie because the screen is too small. Therefore, when Hurtado references transferring DVD content such as films to the end user device (Col. 1, lines 17, 23, 64 for example), one of skill in the art would not find motivation to blend that feature into a hand-held device with low resolution, small screen size and short battery life as is taught by Kikinis.

Another reason there is no suggestion or motivation to combine is that Hurtado is entirely focused on protecting the content itself from being pirated. In contrast, Kikinis focuses on simply the delivery of content to a handheld device by reducing the amount of information via the proxy server application. There is no concern in Kikinis about how to protect content itself from piracy. Columns 9 and 10 of Kikinis discuss the user ID for access to the proxy-server which enables the user to utilize the services of the proxy server for the delivery of reduced content. However, one of skill in the art would readily recognize that Kikinis simply mentions a simple log on feature to the proxy server rather than suggesting any motivation for any kind of protection for the delivery of the content.

Yet another reason that no motivation or suggestion exists to combine these references is that the Examiner's proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes. For example, Hurtado references the type of end-user devices contemplated for use with his invention. Column 14, lines 23 - 48 discuss "PCs, set top boxes (IRDs), and Internet appliances." Hurtado also makes clear that the end-user device is not a portable device because he states that the end-user device "performs the copy to an external media or portable consumer device if permitted." Col. 14, lines 41 - 42. Therefore, when the overall teachings of Hurtado are taken into account, it becomes clear that the secret user key must be stored on the end-user device. (col. 87, lines 33 - 47). The end-user device is not a portable device but is disclosed as a PC, set top box or an Internet appliance. Hurtado makes clear that the end user device can copy content to a

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

portable consumer device if permitted. One of skill in the art would understand the difference in hardware and processing power and battery usage issues between the Hurtado end-user device and a handheld device which is the focus of Kikinis.

Applicants respectfully submit that one cannot blend the end-user device of Hurtado (PC, set top box or Internet Appliance) with a small handheld, battery powered device of Kikinis without changing the principle of operation of one or both of the references. For example, the Examiner asserts that Kikinis' teachings would be obvious to modify with the teachings of Hurtado. However, to so do, the end-user device of Hurtado with its secret user key would be utilized in Kikinis' proxy server invention. But to blend the references in the manner suggested by the Examiner, one would end up with an end-user device such as a PC, set top box, or Internet Appliance that communicates with a proxy server. But a PC, set top box or Internet Appliance are not battery powered and are larger devices that simply have no need of the services of the proxy server to reduce the information from web content. The fundamental principle of operation of Kikinis is eliminated by this blending. For the reasons set forth above, Applicants respectfully submit that there are multiple reasons why one of skill in the art would not find any suggestion or motivation to combine these references.

Furthermore, even if combined, the references still fail to teach each limitation of claim 1. For example, Hurtado simply does not disclose preventing a user from accessing web clipping applications. Hurtado only discloses a secret user key that protects the actual digital content. Therefore, if the Hurtado secret user key were incorporated into Kikinis (and assuming the further modification of Hurtado were made to eliminate the end-user device discussed above), then what would result is the user not being able share web-clipped *content* with other computers. However, access to the web-clipping service would be unimpaired by anything taught in Hurtado. As mentioned above, Kikinis is a content distribution service, and Hurtado is a content encryption/decryption. Therefore, even if the references were

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

combined, the combination still fails to teach the last step of claim 1 because this claim requires that the web clipping *applications* be made available, not the content.

In sum, Applicants submit that a fair analysis of the suggestive power of the entire teachings of Kikinis and Hurtado make it clear that there is no motivation or suggestion to combine their teachings without undue hindsight. Their focus is entirely different and there are a number of reasons why one of skill in the art would not find the legally required motivation for their combination. Accordingly, Applicants submit that claim 1 is patentable and in condition for allowance.

Claims 2 - 8 depend from claim 1 and recite further limitations therefrom. Accordingly, Applicants submit that these claims are patentable as well.

Independent claim 9 is patentable for the same general reasons set forth above. The Examiner asserts that it would be obvious to combine the references because Kikinis could be modified by Hurtado to allow downloading software from the proxy server to the device preventing a user from accessing web clipping applications with the motivation to establish a secure, global distribution system for digital content. Applicants submit that based on the discussion above, it is clear that there is no motivation to combine.

Furthermore, the Examiner asserts that Hurtado teaches a package loaded on the PID wherein the software package compress a registration application and multiple hidden web clipping applications at col. 87, lines 10 - 67. Applicants traverse this interpretation of Hurtado and note our discussion above. Hurtado teaches in column 87 an application installation on an end-user device which we established above was not a portable device. Further, there is simply no mention in Hurtado of a software package comprising "multiple hidden web clipping applications." This is simply not taught by Hurtado or suggested. Again, Hurtado is totally focused on the content itself and on content delivery which is

Application/Control Number: 09/727,908
Art Unit: 2131

Docket No.: PALM-3216

protected from piracy and unapproved sharing. Applicants urge that a fair reading of Hurtado makes this point clear.

Furthermore, column 24, lines 46 - 60 of Hurtado do not teach registering the PID because they are entirely focused on the end-user device which is a PC, set top box or Internet Appliance, not a portable device. For at least these reasons, Applicants submit that claim 9 is patentable and in condition for allowance.

Claims 10 - 14 each depend from claim 9 and recite further limitations therefrom. Accordingly, since the parent claim is patentable, Applicants submit that these claims are patentable as well.

System claims 15 - 20 are patentable for the same reasons set forth above.

CONCLUSION

Having addressed all rejections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

The Commissioner is hereby authorized to charge any necessary fees (or credit any overpayments) associated with this communication and which may be required to Deposit Account No. 50-3102, referencing Attorney Docket No. PALM-3216.

Respectfully submitted,

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